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IN THE

Supreme Court of the United States

OCTOBER TERM, 1970

No. 1603

HELEN WILLS STRONG and KEARNEY, INC., *Petitioners*

v.

GENERAL ELECTRIC COMPANY, *Respondent*

BRIEF IN OPPOSITION TO PETITION FOR CERTIORARI

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STATUTE:

35 U.S.C. § 102(b) 3, 4, 5, 12

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RESPONDENT'S STATEMENT OF THE QUESTIONS PRESENTED

The present petition presents no special or important questions. As is apparent from the carefully reasoned, detailed decisions of the trial judge which were affirmed *per curiam* and adopted by the Court of Appeals, this is and was a "fact" case. No proper questions are presented for review by this Court.

Indeed, petitioners ask this Court to review questions[1] which have been confected from an inaccurate version of the proceedings below. The petitioners' questions are utterly unrelated to the true facts of this case and simply do not involve any issue of law which was actually decided by the courts below.

Because of petitioners' inaccurate statements of what the trial court decided and what the Court of Appeals affirmed, the following statement is provided in accordance with Rule 40-3 of this Court.[2]

STATEMENT OF THE CASE

This is a patent suit, in which both Courts below held the petitioners' Strong and Fisher patents each to be invalid under the absolute rule of the patent stat-

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[1] The *first* question is a complaint that respondent offered an enlarged copy rather than an original page of an admittedly authentic publication, "Electrical South", at the trial. An identical enlarged copy had been authenticated by a Rule 36 admission prior to trial and an original volume of the publication was made available in open court during the trial. The *second* question is another version of attempts made in the Courts below to suggest sympathy for the widow of the deceased patentee Strong as an argument against acceptance in evidence of the invalidating Electrical South publication. The *third* question is framed to suggest that the trial court did not find that the boxes of the patents were "on sale" prior to the critical dates. This suggestion is entirely and obviously erroneous.

[2] Throughout this brief PX and DX followed by numerals will be used to refer to plaintiffs' and defendant's exhibits, respectively. Numerals followed by the lower case letter "a" refer to pages in the printed Supplemental Appendix which has been certified and transmitted to this court. The source, e.g. testimony, will be identified by surname of witness; Findings and Conclusions of District Court identified as "Order (date)"; Admissions identified as "Adm." etc. preceding the designation of pages in the Supplemental Appendix or, if not printed in the Appendix, by reference to the pages of the part of the record involved, e.g. R. —.

ute, 35 U.S.C. § 102(b). The earlier Strong patent was applied for on May 5, 1952. The critical date for this patent is May 5, 1951, for a printed publication of the invention, or its sale or "on sale" or public use, to invalidate the patent under the statute. The subsequent Fisher patent was applied for almost 10 years later, on April 4, 1962, and is directed to a very narrow addition or improvement to the earlier patented Strong meter box. Both the Strong and Fisher patents cover the same meter box made by petitioner Kearney-National.

Following almost 4 years of extensive pretrial proceedings, the issues of invalidity of the Strong patent were tried to the court. After a trial of six days which included: extensive testimony by officers of original plaintiff B&C Metal Stamping Company[3] who were intimately familiar with the meter boxes of both patents and B&C's early commercialization of these meter boxes; testimony of experts for both parties, testimony of officials of Georgia Power Company and the City of Albany, Georgia (early customers of B&C's patented meter boxes); testimony about official records of both Georgia Power Co. and the City of Albany; testimony about publications of admitted and unquestioned authenticity; and after extensive oral argument and full briefing, the District Court held the Strong patent in-

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[3] Petitioner, Kearney-National, Inc., bought out the original plaintiff B&C Metal Stamping Co. of Atlanta, Georgia, and the Strong and Fisher patent rights which had been asserted in this and six other suits. Five of these suits are pending but stayed awaiting final disposition of the present suit. The named petitioner, Helen Wills Strong, has no interest or obligation of expense in this litigation (Strong, 30a). Mrs. Strong did not even know about the filing of the six other suits on the Strong patent (Strong, 30a).

valid under Title 35, United States Code, Section 102(b).

Specifically, the trial court found that in violation of the absolute rule of this statute, more than one year before the May 5, 1952 filing date of the application for the Strong patent, the alleged meter box invention thereof was: (1) Placed on sale to Georgia Power by B&C's own officers; (2) Placed in public use by Georgia Power; (3) Placed on sale and actually sold to the City of Albany by plaintiff B&C; (4) Placed in public use by the City of Albany; and (5) Described in the printed publication Electrical South in January, 1949 (Order, June 12, 1969, 15-22a). These are absolute defenses and any one proscribed activity, a publication, a placing on sale, a sale, *or* a public use more than one year prior to the patent application is alone sufficient to invalidate a patent monopoly.

After the Strong patent had been declared invalid and in order to avoid another expensive trial with respect to the secondary Fisher patent which is concerned with only minor additions to the meter box of the Strong patent and because the pattern of plaintiffs' commercial activities had already been established conclusively by testimony at the trial by petitioners' own admissions, respondent moved for summary judgment of invalidity of the Fisher patent. The motion for summary judgment was based on the same statutory grounds which had been fatal to the Strong patent, i.e., that the Fisher patent was invalid under 35 U.S.C. § 102(b) because of B&C's own commercialization by offers for sale and delivery to customers (the Duke Power Company) more than one year before the April 4, 1962 Fisher application date.

Having heard many hours of testimony in open court from Fisher, the patentee of the Fisher patent and the officer of B&C most intimately familiar with both the Strong and Fisher patents as well as the testimony of Crowe, President of B&C in charge of meter box sales, the trial court was entirely familiar with the simple meter box subject matter as well as the pattern of B&C's usual commercial activities. Indeed, at the six-day trial on the Strong patent, the testimony of Mr. Crowe established that it was customary commercial practice in selling meter boxes to solicit trade from prospective utility customers by submitting samples of such meter boxes to secure their approval so that the seller will be placed on the utilities' approved list (Crowe, 113a-116a).

After full briefing by both parties, the trial court held the Fisher patent invalid because meter boxes of the Fisher patent had been placed "on sale" and in "public use" more than one year before the Fisher patent application had been filed, in violation of 35 U.S.C. § 102(b). This was the same statutory ground as had been the basis for holding the Strong patent invalid. Specifically, the courts below based their holding of invalidity of the Fisher patent on admissions by petitioners that meter boxes of the Fisher patent had been delivered by B&C's chief salesman Crowe to Duke Power Company prior to the April 4, 1961 critical date for the purely commercial purpose of having the Fisher meter boxes put on Duke Power's approved list so that Duke would purchase such boxes from B&C.

The structure of the patented meter boxes is simple and easily understood.

The Strong Patent

As previously noted, the application for this patent was filed May 5, 1952; hence the critical date, one year prior to the filing date, is May 5, 1951.[4]

As best seen in Figure 1 of the patent drawings (117a), the alleged invention of the Strong patent is nothing more than a box having a lid or cover with a hole in it, through which a conventional meter glass enclosure 16 can extend so that the meter can be seen, and hence read, without removing the cover. The hole in the cover is a little bit larger than the protruding glass of the meter, so that the upper edge of the cover can be slipped up under the lip 24 of the top of the box, with the cover tilted (as in Figure 1), and then swung downwardly over the glass meter enclosure and latched by the elements 29, 29′.

The box is constructed of a depth such that the rim or edge of the hole in the cover rests against the conventional enlarged base or rim 15 of the meter (called "the extended flange" in the Strong patent). When the cover is closed downwardly and latched, it holds and locks the meter in place.

This is simple hardware of the most obvious kind.

The electrical meter has conventional socket blades on its rear face so that it can be plugged into terminals mounted on the back of the box just like any other electrical connection is plugged into a socket. Then the cover is applied and latched to lock or seal the meter in place. When the meter is to be removed, the cover is taken off the box. Then the meter can be unplugged

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[4] The Strong patent is reproduced at pages 117-119 of the Supplemental Appendix as Plaintiffs' Exhibit 1, R. 2762.

and taken out just like you can take any other instrument out of a box in which it is mounted after removing the cover.

Meter boxes of the Strong type are known as *ringless* meter boxes to distinguish them from another well known style called "ring" type meter boxes. In the "ring" type the meter is supported on the outside of the box and secured on a special circular flange on the lid of the box, and secured to the lid or cover by a circular clamp known in the trade as a "sealing ring". The Strong patent emphasized as its principal point of novelty the *elimination* of this sealing ring.[5]

In the Strong patent, and in the later Fisher patent as well, the external sealing ring is eliminated because the meter is plugged in before the cover is applied and then the cover with the hole in it is passed over the meter and latched in place to itself lock or seal the meter in the meter box.

The elimination of the sealing ring to provide a "ringless box" was the principal feature emphasized by the Strong patent.

The Fisher Patent

This patent issued from an application filed by B&C's officer, Fisher, on April 4, 1962. The critical date, one year prior to the filing date, is April 4, 1961. The

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[5] The old sealing ring construction is illustrated in Johansson patent No. 2,297,833 in the Supplemental Appendix (PX 45, 134a, R. 3062). The box is shown in red, the cover in yellow. The cover will be seen to have an external outwardly extending bent back yellow flange 19 (Figures 1 and 2) which supports the meter base rim 20 (colored blue). The conventional sealing ring (uncolored, marked by an arrow and "external sealing ring") is wrapped around the flange 19 on the yellow cover and the blue meter base rim to secure the meter to the box.

Fisher patent is reproduced at pages 189-193 of the Supplemental Appendix . The patentee Fisher *himself admitted* that the meter box of this patent is basically the same as that of the invalid Strong patent, differing therefrom only in the addition of an upper flange 50 on the cover (Figure 3, 189a) which has notches at 70 to straddle the flanged edges of the box and a drain gutter 45 on the inside cover or lid (DX 34a, Fisher Dep. 181a, 183a).[6]

The drain gutter 45, like any other old drain gutter has always done, catches water which leaks into the box through the hole in the cover and directs its flow to holes in the bottom.

COUNTER ARGUMENT TO PETITIONERS' FIRST QUESTION

Petitioners ask this Court to review a wholly confected question which has utterly no relationship to the true facts of this case. They contend that the best evidence rule was ignored because the courts below admitted a photocopy of the invalidating 1949 Electrical South publication (DX 7, 141a, R. 3069).[7] The simple answer to petitioners' first question is that it is predicated upon utterly false premises.

The true fact of the matter is that an original copy of the 1949 Electrical South publication, which had been borrowed by respondent from the publisher, *was made available at the trial and in open court* (116a).

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[6] "Q. The two primary improvements over the Strong patent device, right?

A. Right." (DX 34a, 183a)

[7] This trivial matter was briefed in detail before the Court of Appeals and was again thrashed out in oral argument there. It was raised again by a Petition for Rehearing en banc, which was denied.

Moreover, it is also significant to note that petitioners admitted the authenticity of an enlarged photocopy of the *same* pertinent pages from the Electrical South publication, which comprised defendant's trial Exhibit No. 7 (40a). When the photocopy of Electrical South for January 1949 (Defendant's Trial Exhibit 7) was offered and admitted in evidence at the trial, petitioners did *not* raise the "best evidence rule".

Indeed, the authenticity of the photocopy of the Electrical South publication (DX 7) was also confirmed by petitioners' own witness, Mr. Bell, the business manager of the Electrical South trade publication. On direct examination by *petitioners'* counsel, Mr. Bell, who was the business manager of Electrical South in 1949, testified specifically with respect to the photocopy of the portion of the 1949 Electrical South publication which is DX 7:

> "Q. All right. Now, I show you what is entitled Electrical Product Parade, which apparently is a page from Electrical South for January, 1949, previously identified as Defendant's Exhibit 7, and I want to call your attention first that this exhibit has a lot of numbers put in on the box here, and I ask you if you will be kind enough to examine it.
> A. *Yes, that appeared in our pages.*" [8]

Petitioners' first question reduces to nothing more than a trivial complaint of parties dissatisfied with the decisions of four Federal Judges and is based on a wholly artificial and inaccurate version of the facts. The gross inaccuracy of petitioners' first question warrants denial of the petition under Rule 23-4 of this Court.

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[8] Emphasis supplied throughout unless otherwise indicated.

The Decisions of Both Courts Below Holding the Strong Patent Invalid Because the Patented Strong Meter Box Was Described in the Printed Publication Electrical South for January 1949 Are Supported by Overwhelming Evidence.

The trial Court's finding that the Strong patent was invalidated by this printed publication was supported by overwhelming evidence. The printed publication, "Electrical South for January 1949" (DX 7, 141a) was published well over *two* years before the May 5, 1951 critical date of the Strong patent. This 1949 publication shows, pictures and describes a ringless meter box which is *specifically identified as being designed by the patentee Strong* and states that the meter box was "Manufactured and Distributed by B&C Metal Stamping Company" of Atlanta, Georgia, the plaintiff originating this action.

Because the meter boxes are the same, it is in no way surprising that the idea of Strong—the elimination of the sealing ring as well as the other advantages of the Strong meter box described in the Electrical South publication—are the very same as those set forth in the specification of the Strong patent. This is conclusively demonstrated by the side-by-side comparison of the meter box in the 1949 Electrical South publication and the Strong patent at page 1 of the Addendum to this brief.[9]

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[9] The side-by-side comparison at page 1 of the Addendum sets forth in the left-hand column, below a copy of Figure 1 of the Strong patent drawings, quotations from the specification of the Strong patent (PX 1, 117-119a) describing the essential features and advantages of the patented Strong meter box. In the right hand column below a copy of one of the photographic views of the 1949 Electrical South meter box (strikingly similar, if not identical to Figure 1 of the Strong patent) respondent has quoted the essential features and advantages for the same box as described in Electrical South.

Indeed, the identity of the meter boxes portrayed in the 1949 Electrical South publication and the Strong patent was also confirmed by petitioners' own admissions (40-45a), the testimony of Fisher, petitioners' officer (104-105a), as well as the testimony of defendant's witnesses (45a, 96-101a).

It was established by F.R.C.P. Rule 36, Admissions by Plaintiffs Nos. 1, 2, 11, 12, 15-18, 19, and 21-27 that claims 1 to 3 of the Strong patent read directly upon the Electrical South Publication. (40-45a) Defendant's expert Robillard testified that the publication disclosed the ringless meter box structure defined in claims 1-3 of the Strong patent. (Robillard, 96a-101a). Spencer, an engineer with experience in the manufacture of meter boxes testified that he, or even a model maker in the shop, could with the disclosure of Electrical South construct the meter box of the Strong patent. (Spencer, 45a).

The patentee Strong and the plaintiff B&C, who was also informed during the prosecution of the Strong patent, (Fisher, R. 2903) had an uncompromising duty to disclose all of the pertinent facts—the 1949 Electrical South publication as well as the invalidating commercialization of the Strong meter box with the City of Albany and Georgia Power Company (to be discussed hereafter)—to the Patent Office. But no disclosure was ever made to the Patent Office. See ~~in~~ *Precision Instrument Mfg Co.* v. *Automotive Maintenance Co.*, 324 U.S. 806, 818 (1945).

The courts below found that the Electrical South publication was published with the patentee Strong's knowledge and this coupled with failure to disclose such

publication to the Patent Office furnished one more ground for invalidating the Strong patent. But as they did in the courts below, petitioners continue in this Court to ignore the overwhelming evidence supporting the factual findings of the courts below that the meter box of the Strong patent was described in the printed publication "Electrical South" for January 1949 in violation of 35 U.S.C. § 102(b). Petitioners' efforts to divert attention from the true findings of the courts below are even more apparent from their "second question".

COUNTER ARGUMENT TO PETITIONERS' SECOND QUESTION

Petitioners' second question is but another version of their efforts in the courts below to enlist sympathy for the widow of the patentee Strong, and thereby somehow support ~~of~~ their argument against the acceptance in evidence of the invalidating Electrical South publication (DX 7). Petitioners' second question is only an emotional effort inaccurately and unfairly characterizing the decisions of the courts below.

Specifically, petitioners' description of what the courts below held based on *Marconi* v. *United States,* 320 U.S. 1 (1943) is grossly inaccurate. At pages 5-6 of their brief petitioners seek, as they unsuccessfully did in both courts below, to distinguish *Marconi* because the patentee Fleming there was knowingly claiming something which had been invented by others (Edison) whereas in the present case Strong did not attribute the meter box shown and described in the Electrical South publication to someone else. Such a distinction is without merit.

In *Marconi* this Court condemned holding out to the public as a monopoly patent claims which are known to be of invalid scope. This Court in Marconi stated:

> "For ten years the Fleming patent was held out to the public as a monopoly of all its claimed features. That was too long in the absence of any explanation or excuse for the delay, and hence in this case was long enough to invalidate the patent." (p. 59 of 320 U.S.)

In the present case, the patentee and petitioners secured claims to which they were not entitled, not only because of the 1949 Electrical South publication, but also because of petitioners' *own* invalidating prior sales, placing on sale and public uses involving the City of Albany and the Georgia Power Company. In spite of these known invalidating activities, the claims of the Strong patent were prosecuted in the Patent Office for nine years, and were being held out to the public as a lawful monopoly for eight more years since issuance of the Strong patent. These claims are still the subject of five other pending civil actions.[10] Like *Marconi,* no explanation or excuse has ever been given.

The duty to disclose prior invalidating publications and activities has been recently emphasized in *Beckman Instruments, Inc.* v. *Chemtronics, Inc.,* 428 F. 2d 75 (5th Cir. 1970) *cert. denied* 27 L. Ed. 2d (Dec. 14, 70) where the Fifth Circuit Court of Appeals stated:

> "* * * We conclude that there was no excuse for appellants' failure to disclose Stow's work to the

[10] In the sixth suit, the United States District Court for the Western District of Missouri, Western Division has entered a declaratory judgment of dismissal holding the Strong and Fisher patents invalid and unenforceable with leave to reinstitute the suit in the event the decision of the trial court here is reversed.

> Patent Office, and this conclusion prevents us from considering Beckman's conduct as fulfilling an 'uncompromising duty' of good faith disclosure. We are constrained to hold the patent invalid on this ground, also."

It is conceded that Strong knew of the 1949 Electrical South publication, which completely anticipates claims 1 to 3. Strong secured his patent without revealing this invalidating publication to the Patent Office. The courts below both found the entire patent, including claims 4 and 5, to be invalid. Claims 4 and 5 claim the same ringless meter box combination disclosed in the 1949 Electrical South publication, plus the recitation of a very minute detail—the conducting fingers.[11]

COUNTER ARGUMENT TO PETITIONERS' THIRD QUESTION

Petitioners' third question improperly and erroneously suggests that the courts below did not hold that the boxes of both the Strong and Fisher patents were "on sale" prior to the critical dates for these patents. But the true fact is that the trial court found that the meter boxes of both the Strong and Fisher patents were

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[11] The use of conducting or grounding fingers as required is so old and obvious an expedient in the electrical art that no novelty could properly be asserted therefor. Indeed, two old prior patents, Kempton, 1,967,091 (DX 21) of 1934 show an electrical plug connector with grounding fingers in a receptacle to make a ground when the blades are plugged. Road patent 2,367,433 (DX 9) shows it was old to ground meters to their boxes using grounding fingers (Spencer, 52-54a, 79-80a). See *Dix Seal Corp* v. *New Haven Trap Rock Co.*, 236 F. Supp. 914, 918-921 (D. Conn. 1964); *Gunter & Cook Inc.* v. *Southern Elec. Service Co.*, 256 F. Supp. 639, 649, 652-653 (M.D.N.C. 1966), aff'd. 378 F. 2d 60 (4th Cir. 1967).

"on sale" prior to the respective critical dates for these patents. (Order, June 12, 1969, 19a; Order October 21, 1969, 24a). The Court of Appeals affirmed and adopted these decisions.

Aside from the inaccuracy of the manner in which petitioners' third question is framed, the arguments at pages 7-10 of the petition reveal that as in the Court of Appeals below, petitioners are merely continuing to quarrel with the trial court's findings of fact in an improper effort to retry these findings in this Court. Petitioners also made the same contention in a petition for re-hearing en banc in the Court below, but the petition was denied.

Not only did both courts below find that the patented Strong meter box had been placed on sale by B&C's extensive commercialization of the patented meter box with Georgia Power Company, but both courts also found that the patented Strong ringless meter boxes had *actually been sold* by B&C to the City of Albany, Georgia, prior to the critical date. The invalidating actual sales of the Strong meter boxes to the City of Albany are barely touched on, and then only as an afterthought, at page 10 of the petition. Even petitioners' brief reference to the City of Albany defense is misleading and inaccurate.

There Was Overwhelming Evidence Establishing That the Patented Strong Ringless Meter Boxes Had Been Actually Sold by B&C to the City of Albany Prior to the Critical Date.

After many hours of live testimony from witnesses for both sides with the important opportunity to observe these witnesses and draw inferences, the trial judge resolved the disputed fact issues with respect to the City of Albany defense by finding that *"B&C*

did in fact sell Strong meter boxes to the City of Albany more than one year before the Strong application". (Order, June 12, 1969, 19a)

The trial court's findings which were adopted and affirmed by the Court of Appeals, are supported by overwhelming evidence which included the testimony of Charlie G. Mann, the Meter Superintendent of the City of Albany, Mr. Fisher, an officer of B&C since 1946, as well as official records of the City of Albany of unquestioned authenticity. The evidence at the trial included the following documentary records from the files of the City of Albany, with respect to the purchase of *50* of the Strong meter boxes in 1950 long before the Strong patent's May 5, 1951 critical date:

1. A City of Albany Purchase Order No. 3284 dated April 29, 1950 (DX 10B, 143a) ordering 50 B&C meter boxes No. WV-011 through a local electrical supplier, Electric Equipment Co., at a unit price of $2.48 each; (Mann, 70a; Bierman, 55-56a; Hope, 61-62a)

2. A City of Albany Receiving Report (DX 10C, 144a) showing the receipt on June 9, 1950 by the City of Albany of the 50 B&C meter boxes WV-011 ordered by the April 29, 1950 Purchase Order No. 3284 (DX 10B) (Mann, 70a; Bierman, 56a; Hope, 62-63a);

3. An invoice No. 2441 (DX 10D, 145a) of the local supplier, Electric Equipment Co., to the City of Albany, dated June 6, 1950 for the 50 B&C meter boxes covered by the Purchase Order (DX 10B, 143a) at the purchase order unit price of $2.47 each and a total price of $123.50 (less $2.47 discount); (Bierman, 57a)

4. A City of Albany check voucher dated June 30, 1950 (DX 10A, 142a) showing payment of invoice

No. 2441 (DX 10D, 145a) in the sum of $123.50 (less $2.47 discount) by the City of Albany to Electric Equipment Co. (Bierman, 57a).

Similar records in evidence, and also established by testimony, cover the reordering and sale of *200* of these same B&C meter boxes WV-011, which were delivered to Albany on February 27, 1951. (DX 13, 15a; DX 12B, 147a; DX 14, 151a; DX 12C, 148a; DX 12D, 149a; and DX 12A, 146a; Mann 51a, Bierman, 57-59a, R. 3157-3158, and Hope 63-64a).

The trial court's finding of fact that these B&C No. WV-011 meter boxes sold to Albany were the patented ringless Strong meter boxes also finds overwhelming support both in the testimony of Mann, the Meter Superintendent for the City of Albany since 1932, who was intimately familiar with the B&C meter boxes purchased by Albany and also the testimony of B&C's own officer Fisher. Mr. Mann testified that these 1950-51 meter boxes were "ringless" (Mann, 71a) and were the same as the B&C ringless meter box No. WV-011 shown at page 29 of B&C's catalog (Dx 15, 152a, Mann, 77-78a).

B&C's officer Fisher testified that B&C's catalog No. WV-011 *originated* with the patented Strong ringless meter box and also clearly identified it with the Strong patent. (Fisher 32a-33a)[12]

Each of the actual sales in June, 1950 and again in February 1951 of B&C meter boxes No. WV-011 is prior to the May 1951 critical date and each is sufficient

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[12] E.g. Q. "Isn't it true that WV-011 is the Strong ringless type socket?

A. *"The WV-011 is a Strong ringless socket, yes, sir."* (Fisher, 33a)

in and of itself to invalidate the entire Strong patent. In *Consolidated Fruit Jar Co.* v. *Wright,* 94 U.S. 92 (1877), this Court said:

> "It follows that a *single instance* of sale or of use by the patentee may, under the circumstances, be fatal to the patent."

The gross inaccuracy of petitioners' statement that "the only evidence submitted in support of this defense was two purchase orders dated prior to the critical date of May 4 (sic) 1951 bearing the indicia 'WV-011,' " (Petition, p. 10) justifies denial of the Petition.

In view of the overwhelming documentary evidence and testimony supporting the trial court's finding that "*B&C did in fact sell* Strong meter boxes to the City of Albany more than one year before the Strong patent application was filed" (Order, June 12, 1969, 19a) petitioners' statement at pages 10 of the Petition that "There is no evidence that petitioners engaged in any commercial or competitive exploitation of its meter boxes prior to the critical dates" is both inaccurate and incredible.

It is also obvious that these Strong meter boxes were being used in the usual course of business by the City of Albany. After the first delivery of *50* boxes in June 1950 Albany found it necessary to reorder *200* more of these same boxes in November 1950. As Mann testified, "when the stock is down so low, they have to reorder." (Mann, 69a)[13]

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[13] The evidence also included two official City of Albany Work Orders (DX 16 and 17; 153a, 155a) which establish that on October 23, 1950, electrical service was installed at two houses, 1312A and 1312B Whitney Street, Albany, Georgia, by the plugging in of a socket type electric meter into each of two meter boxes which were installed on these houses. Defendant's Exhibits 19A, 19B, 19C and 19D (157-160a) are photographs showing the meter boxes in-

In assessing the credibility of the witnesses and weighing the evidence in making his detailed findings of fact, the trial judge also had before him petitioner's admission that on March 5, 1951, B&C delivered *98* ringless meter boxes with the same catalog number, No. WV-011 to Georgia Power Company. Petitioners admitted that these *were* the ringless meter boxes of the Strong patent. (Fisher 106a, 108a). The delivery of these 98 meter boxes on March 5, 1951 to Georgia Power was *only six days* after the February 27, 1951 delivery to Albany of B&C meter boxes designated by the identical catalog No. WV-011.

Both Courts below held the Strong patent invalid because of B&C's sales of the Strong meter box to Albany in 1950 and February 1951. B&C's further commercialization of the Strong meter box with Georgia Power Company prior to the critical date simply furnished still another separate ground upon which both Courts also held the Strong patent invalid.

The Strong Patent Was Also Held Invalid Because of B&C's Further Commercialization of the Patented Strong Meter Box WV-011 With Georgia Power Company Prior to the May 5, 1951 Critical Date. Overwhelming Evidence Supports the Finding That the Boxes Were Placed "On Sale" Prior to the Critical Date.

After the actual sales to the City of Albany in June 1950 and February 1951, *over five hundred* B&C ringless meter boxes No. WV-011 were delivered to the

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stalled on these houses at 1312A and 1312B Whitney Street (Mann, 75-76a). Mann said that Albany was issuing the same type meter boxes as those shown in the photographs (DX 19-A-D), at the time of the installation in October 1950, and he identified these boxes as B&C ringless meter boxes No. WV-011. (Mann, 76-77a) It is both common and expected for meter boxes installed in 1950, and even earlier, to be in service at the present time. (Mann, R. 3295-3296; See also Fisher, R. 2846)

Georgia Power Company by B&C in March and April 1951, well prior to the May 5, 1951 critical date for the Strong patent.

Whitmer, Manager of Purchases and Supplies for Georgia Power testified that these March and April deliveries were recorded in the usual course of business on the standard stock records of Georgia Power (DX22, 163a; DX23, 164-165a) and were in partial fulfillment of an order for 1280 meter boxes. (Whitmer 83-84a; 93-94a). Similar subsequent periodic shipments were received by Georgia Power until the order was completed on October 18, 1951 (Whitmer 83a, 93a). There is no dispute that all of these were the patented Strong meter box. Fisher testified that these boxes embodied the alleged meter box invention of the Strong patent, including even the little "conducting fingers." (Fisher 106a, 108a).

During March and April 1951, 61 of these patented Strong meter boxes No. WV-011 (along with other ordinary stock materials) were withdrawn in the customary manner, using standard Material and Supply Request forms (DX 24, 25, 26, 27 A-D, 166-173a) from Georgia Power's warehouse stock by various Georgia Power divisions in Columbus, Atlanta, Rome, Macon, Americus, Tifton, Manchester and Albany, Georgia, for use in supplying electrical service to customers. (Whitmer 88-93a).

The Trial Court found:

> "The evidence clearly shows that B&C Metal Stamping Co. (the first exclusive licensee) considered the Strong meter box to be marketable and *was in fact making great efforts to sell the boxes to Georgia Power* and to others as well." (Order, June 12, 1969, 19a)

> "The court finds that *B&C did in fact sell* Strong meter boxes to the City of Albany more than one year before the Strong patent application was filed and that it delivered meter boxes to Georgia Power Company *to be used* in whatever manner that company chose, *without restriction.*" (Order, June 12, 1969, 19a)
>
> "The Court holds, therefore, that either the City of Albany or the Georgia Power Company transactions would be sufficient to establish that *the Strong meter boxes were on sale* as well as in public use prior to May 5, 1951 . . . ." (Order, June 12, 1969, 19a)

Petitioners unsuccessfully argued in both courts below that all of these Strong meter boxes were delivered for "experimental" purposes and were given rather than sold to Georgia Power. In their petition, petitioners now merely assert that the meter boxes were "given" to Georgia Power and do not even allege their purpose to have been experimentation.[14] There is utterly no merit in Petitioners' gift contention.

The purely commercial character of B&C's delivery of hundreds of Strong meter boxes which were treated by B&C's customer, Georgia Power like other ordinary stock item and widely distributed in the usual course of business to Georgia Power's field offices for use in supplying electrical service to customers, was clearly established by the testimony of B&C's own officers Fisher and Crowe.

The testimony of Crowe, B&C's President and in charge of B&C's sales established that it was customary in selling meter boxes to solicit trade from prospec-

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[14] No evidence of any experimentation was ever offered by petitioners in the courts below. See *Smith & Griggs Mfg. Co.* v. *Sprague,* 123 U.S. 249, 31 L. Ed. 141, 146 (1887).

tive utility customers by displaying or submitting samples of such meter boxes to secure approval so that the seller will be placed on the utilities approved list. (Crowe 113a, "I don't care what you're selling the first thing you've got to do is get on the approved list." 114-116a)[15]

In January, 1951, Fisher, was "out after new business" and went to Jim Raney, who was in charge of Georgia Power's meter department with the ringless meter box of the Strong patent for the purpose of securing "business" from Georgia Power. (Fisher 106-107a) Since Georgia Power was one of the largest utilities in the south, Fisher said, "we knew if we could do business with the Power Company, that some of the other utilities certainly would follow suit." (Fisher 107a)

There can be no real doubt that B&C's *purpose* in delivering more than 500 of the Strong meter boxes to Georgia Power was commercial, i.e., *to sell meter boxes.*

At the same time Fisher was soliciting Georgia Power's business, Crowe, B&C's chief salesman, was displaying and offering samples of the same ringless meter box of the Strong patent to other prospective utility customers. (Crowe, 113-114a) Crowe succinctly characterized B&C's commercial purpose in delivering the Strong meter boxes (or sockets as they are also known) to Georgia Power when he testified "We wanted them to *buy* sockets . . . . " (Crowe 116a)

The words of petitioners' counsel at the trial, in themselves, conclusively support the findings of both

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[15] Of course, this custom of submitting samples is likewise applicable to the invalidity of the Fisher patent, discussed hereinafter.

courts below that the Strong patent is invalid because the Strong meter boxes were "on sale."

> "The Court: I get the impression from Mr. Fisher and Mr. Crowe that *they badly wanted to peddle some boxes to Georgia Power Company.*
> Mr. Ames: *Right. They wanted to peddle boxes anywhere they could.* And they wanted to get on the approved list for *purposes of sale.*" (116a)

The Meter Box of the Fisher Patent 3,123,744 Was Also Commercialized by Plaintiff B&C More Than One Year Prior to the Filing Date of Its Application. It Is Invalid for Essentially the Same Reasons Which Were Fatal to the Strong Patent.

As noted earlier in this brief, the Fisher meter box is nothing more than the Strong meter box with the addition of a notched upper flange 50 and drain gutter 45 on the Strong cover.

Both courts below found that the same pattern of commercial acts had been engaged in by B&C with the Fisher meter box as had occurred with its earlier version, the Strong meter box.[16] Specifically, petitioners admitted and the trial court found that the samples of the patented Fisher meter box "were given to Duke Power Company for the express purpose of getting them put on Duke's approved list so that Duke would *purchase* boxes of that type from B&C". (Order, October 21, 1969, 24a)

The trial court also found that petitioners delivered these Fisher meter boxes to Duke Power for "unrestricted use in March 1961, 13 months before" the

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[16] The petition states that the facts with respect to the delivery of the Strong meter box to Georgia Power are substantially the same as the transfer of the Fisher meter boxes to Duke Power Co. (Petition, p. 8)

Fisher application was filed and petitioners' delivery of the boxes for the purpose "of having the boxes approved—a necessary prerequisite to Duke purchasing the boxes"—constituted placing the boxes *on sale.* (Order, October 20, 1969, 24a, 26a)

As discussed earlier in this brief, petitioners' officer Crowe, who was in charge of sales and who delivered these Fisher meter boxes to Duke Power, admitted that the purpose in delivering samples was to sell meter boxes. Crowe testified at his deposition (DX 35, 18-19):

> Q. "Of course, that is the reason for taking samples around, you—
> A. Absolutely.
> Q. —*Want to make a sale,* don't you?
> A. *Yes.*"

This customary selling practice in the utility trade, which is no different than the familiar customer try-ons of clothing in a haberdashery, or the potential purchaser's test drive of an automobile, was also confirmed by Crowe's testimony at the trial. (Crowe, 113-116a)

Duke became B&C's largest customer for these Fisher meter boxes. (Crowe Dep. DX 35, pp. 3-4, 186a) Petitioners admit that without doubt the Fisher boxes were placed on Duke Power's approved list. (Petition, p. 8)

These unchallenged facts conclusively establish that the Fisher meter box, just as the Strong meter box with Georgia Power, was placed on sale prior to the April 4, 1961 critical date for the Fisher patent.

See *Chicopee Mfg. Corp.* v. *Columbus Fiber Mills,* 165 F. Supp. 307 (N.D. Ga. 1958) "The statutory language is 'on sale' not 'sold'. Accordingly, an actual

sale is not necessary"; *Minnesota Mining & Manufacturing Co.* v. *Kent Industries,* 247 F. Supp. 993, 999 (D. Mich. 1967) "A free sample or offer for sale is also within the 'on sale' provision of the statute", *aff'd.* 409 F.2d 99 (6th Cir. 1969). See also *Dalby* v. *Lynes,* 64 Fed. 376, 378 (C.C. Mass. 1894) and *Philco Corp.* v. *Admiral Corp.,* 199 F. Supp. 797, 816 (D. Del. 1961) where display of samples was "competitive use".

This is precisely the same kind of commercial activity which plaintiffs engaged in with respect to the Strong meter box prior to the critical date for that patent.[17]

In this regard it is also noted that petitioners, for the very first time in the long and extensive record in this case, try to suggest that the Fisher meter boxes delivered to Duke Power and the Strong meter boxes delivered to Georgia Power were "incomplete" because they did not include the electric meters. (Petition, pp. 7-8). Any such contention is utterly lacking in merit and contrary to the record in the courts below. The alleged invention of both the Strong and Fisher patents related only to the meter box and had nothing whatever to do with the electric meter itself which is a standard and conventional device. Petitioners' counsel conceded this in the following colloquy with

[17] At page 9 of their petition, petitioners cite *Amerio Contact Plate Freezers, Inc.* v. *Belt-Ice Corp.,* 316 F.2d 459 (9th Cir. 1963) wherein the crucial finding of fact upon which the decision of the court turned, was that a freezer machine embodying the patented invention had *not been constructed* prior to the critical date. Unlike *Amerio,* both the patented Fisher meter boxes and the patented Strong boxes in the present case were fully completed and delivered to Duke Power and Georgia Power prior to the critical dates.

the trial judge regarding a conventional *electric meter* (PX 10):

> Q. "Mr. Fisher, I hand you what's been identified as Exhibit 10 for identification . . ."
> The Court: Mr. Ames, is there any contention that this in any way portrays or represents or—
> Mr. Ames: *No.*
> The Court: —the invention involved in this case?
> Mr. Ames: *None whatsoever.*
> The Court: You're just showing what a meter is in general?
> Mr. Ames: Right. This is a meter. The invention is *strictly the box* that the meter goes in." (R 2810)

During the six-day trial on the Strong patent, the District Court not only became thoroughly familiar with the meter box subject-matter, but also with the admitted pattern of petitioners' commercial activities, namely, its customary sales procedure of delivering samples of the meter boxes *which it wishes to sell* to its respective utility customers. There can be no question about petitioners' purpose in delivering these samples. It was the pure business purpose *to sell meter boxes.*

The commercial character of Crowe's delivery of the sample Fisher meter boxes to Duke Power is also confirmed by the fact that they were delivered by Crowe, B&C's chief *salesman.* Crowe testified at the trial he was not an engineer, but that his job was to "try to sell" (Crowe, 113a).

In the case of both patents, the trial court found that the respective meter boxes had been placed on sale prior to the critical dates. There was substantial evidence supporting these findings and the Court of Appeals affirmed.

CONCLUSION

There should be an end to this protracted litigation. This case has been pending for over five years, and five other actions on the same invalid patents are pending in the trial court below awaiting the final disposition of this suit.

The Strong patent is invalid on *any one* of the defenses (Albany, Georgia Power and the Electrical South publication) each of which both courts below found to be fatal to its invalidity.

The Fisher patent which in effect repatents the same box as that of Strong, plus two non-inventive and trivial features (notched flange on the lid and drain gutter), was held invalid by both courts below because the Fisher box was also on sale to Duke Power more than a year before Fisher's application.

The trial court's decision was based on extensive factual findings and the application of well established principles of law. In a per curiam decision the Court of Appeals adopted and affirmed the district court's "cogent opinions."

Respondent respectfully submits that the decision reached by both courts below was entirely just and involves no error nor misapplication of the law, nor any conflict between decisions of different Courts of Appeal nor any question of possible interest or importance which should absorb the time of this Court.

It is submitted that the Petition should be denied.

Respectfully submitted,

JOHN W. MALLEY
EDGAR H. MARTIN

ADDENDUM

THE STRONG PATENT

ELECTRICAL SOUTH FOR JANUARY 1949

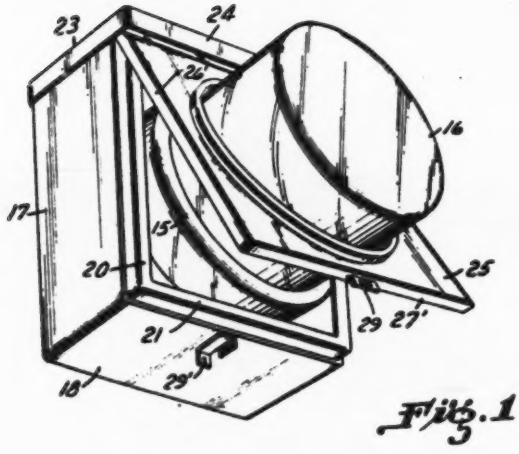
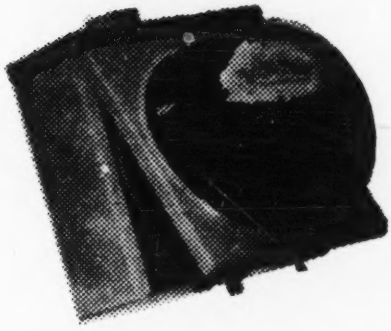


Fig. 1



Patentee: "Carll W. Strong

"An object of my invention is to provide a meter box in which a socket type meter is fastened in place in the box by means of a friction flange and the front of the meter box, and *no separate sealing ring is needed.*" (Col. 1, lines 29-32)

"Another object of my invention is to provide a meter box which *will permit the use of any type of socket meter,* will make *installation easier,* render the meter box *more accessible for inspection, provide more wiring space* and *permit the installation of larger conduit* than is possible with the meter boxes in use today." (Col. 1, lines 36-41)

"Designed by Carll W. Strong

"The *Elimination of the sealing ring* is one of the outstanding advantages of this new line of socket-type meter enclosures. . . . In this design, for which patents are now pending, *the meter is sealed securely in place by the cover which rests firmly against the meter base rim.*"

"Among the advantages claimed for this new box by its manufacturers are: *more wiring space* and *easier installation, better accessibility for inspection, suitable for use with any type of socket meter, allows use of larger conduits* when desired, and completely *eliminates the use of socket ring* and supporting bar used in some other socket type meter enclosure."